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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,187	03/08/2001	Kazuyuki Yokokawa	P66458US0	4101

7590 09/09/2003
Oppenheimer Wolff & Donnelly LLP
2029 Century Park East, 38th Floor
Los Angeles, CA 90067-3024

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,187

Applicant(s)

YOKOKAWA, KAZUYUKI

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 78-142 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 78-142 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 27, 2003 has been entered.
2. Applicant's arguments with respect to claims 11-44 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 78- 87, 89-103, 105-119, 121-135 and 137-142 are rejected under 35 U.S.C. 102(b) as being anticipated by Cancio (4,380,564 or 4,465,729).

Cancio relates to a sheet structure having intersecting continuous tear lines formed in the surface thereof (abstract). The tear lines are grooves (16) and (18) as shown in figure-2 along which the sheet is divided into a plurality of portions. The sheet material can be resin film or its laminate with paper (col.4, lines 64-65 of Cancio'564 and col.4, lines 57-59 of Cancio'729). The film is provided to receive prints or decorative designs

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on its surface. Further, because Cancio teaches that "sheet may be provided with adhesive" (Cancio'564; col.2, lines 33-34 and Cancio'729; col.2, lines 40-41), said phrase infers to the possibility of the sheet material being without adhesive.

When the adhesive is present, both the resin film and the adhesive layer are provided with the grooved tear lines. The tear lines provides for tearing off or folding along said lines (Cancio'564; col. 5, lines 50-54). Folding or bending along said cutlines would inherently provide for split therealong.

The adhesive can have protective release liner thereon.

The cutlines or grooves form an entire perimeter of at least one sheet portions.

The intended use phrases such as "can be bent", "printable", "can be split", "when separated", etc. have not been given any patentable weight because said phrases are not deemed to be of positive limitation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cancio in view of Kishimoto (5,560,9660).

Cancio'564 or '729, as discussed above, fails to teach expressly that the resin film is overlaid with an image receiving layer coat. Kishimoto relates to a resin film with tear line (abstract). The film is provided thereon with a light sensitive layer, or printed, or

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processed image layer (col.3, lines 10-12). The presence of processed or printed image layer indicates the presence of image receiving layer coat and that said image and print are functionally equivalent to provide decorative effect thereto. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Kishimoto's teaching that printed indicia and processed image are functionally equivalent and that processed image can be substituted for the print in the invention of Cancio.

Response to Arguments

7. Applicant's arguments filed June 27, 2003 have been fully considered but they are not persuasive.

Applicant argues that the phrases, such as "can be bent at least one of upwardly or downwardly..." are structural limitations, that all limitations must be considered by the examiner and that it is improper by the examiner to ignore specific limitations. These are not deemed to be convincing because the phrases, such as "can be bent...", etc. and other similar phrases discussed hereinbefore, are found to be intended use phrase. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate it from the prior art apparatus satisfying the claimed structural limitations. See *Ex Parte Masham*, 2USPQ2d 1647 (1987). Further, contrary to applicant's allegation, all limitations in the claims have been given weight by the Examiner and none were ignored. However, the intended use phrase were not given patentable weight for reasons discussed hereinabove.

Applicant also argues that Cancio teaches tear lines and not lines for bending and splitting as claimed in the instant application. This is not found to be convincing

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because that applicant has failed to show that the Cancio sheet would not be bendable along its cutlines. Applicant should note that Cancio's use of the "tear line" phrase does not mean that the sheet cannot be folded therealong, and that folding or bending would inherently provide for splitting.

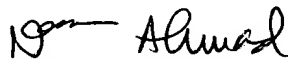
Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is deemed to be anticipated or rendered obvious over the prior art of record discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is (703) 308-4424. The examiner can normally be reached on Monday through Thursday from 7:30AM to 5:00PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.

September 8, 2003.